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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,554	04/08/2004	David H. Tannenbaum	05708/P005DIV/08008819	8358
29053	7590	06/29/2006	EXAMINER	
DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P. 2200 ROSS AVENUE SUITE 2800 DALLAS, TX 75201-2784			SALTARELLI, DOMINIC D	
		ART UNIT	PAPER NUMBER	2623

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/820,554	TANNENBAUM, DAVID H.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Dominic D. Saltarelli	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 25 May 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 47,48,57,72-76 and 79-90 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 47,48,57,72-76 and 79-90 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/25/06</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 25, 2006 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 47, 72, 75, 76, and 79 have been considered but are moot in view of the new grounds of rejection.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 47, 48, 57, and 72-75, and 79-90 are rejected under 35 U.S.C. 102(e) as being anticipated by Jackson (5,963,264).

Regarding claim 47, Jackson discloses a method of adjusting recording time of an entertainment program (col. 2, lines 41-67), said method comprising:

selecting an entertainment program to be communicated to a user's premises (col. 4, lines 50-58 and col. 5, lines 51-56), said program having scheduled start and stop times (program initiation and termination information, col. 4, lines 26-34),

inputting a specifically identified start and stop time into a recorder in accordance with said identified scheduled start and stop times for recording said selected program at said user's premises (EPG selections 7 are stored in nonvolatile memory 15, thus the program initiation and termination times identified in EPG 22 upon user selection of a program are input into memory 15, col. 5, lines 8-15 and lines 51-56),

upon receipt of a message from a source of said selected program and without action taken by said user, adjusting an established stop time of said recorder to accommodate subsequent changes in program length, said adjusting in accordance with stop times contained in said message (new EPG data with new program initiation and termination times are received and used to update the times stored in memory 15, col. 5, lines 8-15).

Regarding claim 48, Jackson discloses the method of claim 47, wherein said changes in program length occur after the start time of said program (such

as when a sporting event unexpectedly goes into overtime, col. 5, lines 63-66, see also col. 6, lines 3-20).

Regarding claim 57, Jackson discloses the method of claim 47, further comprising transmitting for recording at said user's premises said selected program in accordance with said established start and stop times (col. 5, lines 16-32).

Regarding claim 72, Jackson discloses a method for the delivery from a delivery source of entertainment programs for delayed viewing by recipients of said entertainment program (col. 2, lines 41-67), said entertainment program having an unknown length (such as sporting events, col. 5, lines 63-66), said method comprising:

establishing a starting time (program initiation information, col. 4, lines 26-34) for a particular entertainment program so as to allow for the setting of a recorder at said recipient's premises for recording a delivered one of said entertainment programs starting at said starting time (col. 5 line 51 – col. 6 line 2); and

communicating from said delivery source to said recipient's recorder while said recording is recording said particular entertainment program, a message when the length of said particular entertainment program becomes ascertainable by said delivery source so as to enable said recipient's recorder to stop recording

said entertainment program in accordance with said message, wherein said message contains therein stop time data (last minute updates to EPG information are transmitted to input a stop time into memory 15 to control the time when a VCR stops recording a program, col. 5, lines 8-15 and col. 5 line 33- col. 6 line 20).

Regarding claim 73, Jackson discloses the method of claim 72, wherein said setting of said recorder is under the direct control of said recipient (users select which programs they wish to record, col. 4, lines 50-58).

Regarding claim 74, Jackson discloses the method of claim 72, further comprising:

receiving from said recipient listings of entertainment programs desired to be received by said recipient (col. 4, lines 50-58); and  
wherein said setting of said recorder is under control of said delivery source based upon received ones of said desired entertainment program (delivery source delivers EPG data which controls VCR recording, col. 4, lines 26-34 and col. 6, lines 3-20).

Regarding claims 75, Jackson discloses a method for the recording of entertainment programs at a recipient's location (col. 2, lines 41-67), said entertainment programs received from a delivery source (col. 2, lines 41-54), said

entertainment programs having an unknown length (such as sporting events, col. 5, lines 63-67), said method comprising:

setting of a recorder at said recipient's premises (col. 4, lines 50-58 and col. 5, lines 16-32) for recording a delivered one of said entertainment programs starting at a time as determined by said delivery source (program initiation information, col. 4, lines 26-34), and

receiving by said recorder a message containing a stop time from said delivery source when the length of said entertainment program becomes ascertainable by said delivery source so as to enable said recorder to stop recording said entertainment program at said received stop time, and wherein said stop time corresponds to the ascertained stop time of said entertainment program, wherein said message is received during delivery of said entertainment program to said user (last minute updates to EPG information are transmitted to input a stop time into memory 15 to control the time when a VCR stops recording a program, col. 5, lines 8-15 and col. 5 line 33- col. 6 line 20).

Regarding claim 79, Jackson discloses a method for recording TV programs at a user's premises, said TV programs delivered over a plurality of user selectable channels by a delivery source, said programs scheduled to begin at particular times (col. 2, lines 41-67), said method comprising:

setting in a recorder at said user's premises a particular channel and a particular start time corresponding to a program desired to be recorded by said

user (EPG selections 7 are stored in nonvolatile memory 15, thus the program initiation and channel identified in EPG 22 upon user selection of a program are input into memory 15, col. 5, lines 8-15 and lines 51-56); and

receiving from said delivery source a message for use by said recorder to adjust said stop time in accordance with a revised stop time as contained in said received message (revised EPG data with a new stop time, col. 2, lines 64-67; col. 5, lines 8-15; col. 5, lines 33-50), said message received during receipt of said desired program by said user (col. 5, lines 63-67).

Regarding claim 80, Jackson discloses the method of claim 79, wherein said message from said delivery source is received contemporaneous with the end time of said desired program (changes occur up to the last minute, col. 5, lines 40-41).

Regarding claims 81-85, Jackson discloses the methods and device of claims 47, 72, 75, 76, and 77, wherein the stop time message is delivered to said recorder from said delivery source by a medium other than the entertainment program (stop times are contained within EPG data updates, col. 2, lines 41-54 and col. 4, lines 26-34).

Regarding claims 86-90, Jackson discloses a method for changing the record times of a user's recorder (col. 2, lines 41-67) said method comprising:

inputting for storage in a user's recorder specific start and stop times (program initiation and termination information, col. 4, lines 26-34) of a particular program to be delivered to said user from a program source (col. 4, lines 50-58 and col. 5, lines 8-15); and

without action taken by said user, receiving from said program source a message to delay a stored stop time for said particular program (revised EPG data contains a new stop time which delays the previous stop time to accommodate and extension in program length, such as for a sporting event which goes into overtime, col. 5, lines 64-67, see also col. 6, lines 3-20).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 76 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson.

Regarding claim 76, Jackson discloses a device for recording of entertainment programs at a recipient's location (col. 2, lines 41-67), said entertainment programs delivered from a delivery source (col. 2, lines 41-54), said entertainment programs having an unknown length (such as sporting events, col. 5, lines 63-67), said device comprising:

memory (fig. 1, memory 15) for storing start and stop times for allowing said recorder to record a delivered one of said entertainment programs starting at said start time as determined by said delivery source (col. 5, lines 8-32 and col. 6, lines 3-21); and

means for receiving a message from said delivery source during the delivery of said entertainment program when a revised stop time of said entertainment program of said entertainment program becomes ascertainable by said delivery source, said revised stop time being substituted in said memory for said originally stored stop time (last minute updates to EPG information are transmitted to input a stop time into memory 15 to control the time when a VCR stops recording a program, col. 5, lines 8-15 and col. 5 line 33- col. 6 line 20).

Jackson fails to disclose the memory is in said recorder.

Examiner takes official notice that it is notoriously well known in the art to place the memory which stores the start and stop times for controlling recording within the recorder, for example, conventional VCRs have a memory which stores information such as the date, start/stop times, and channel for controlling the recording process of the VCR.

It would have been obvious at the time to a person of ordinary skill in the art to modify the device disclosed by Jackson to simply place the memory within the recorder.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Jo (5,237,462) which teaches a system for adjusting the stop time for recording of a VCR.

Chen et al. (5,767,893) which teach controlling a VCR with messages sent from a content source to ensure a program is recorded properly in spite of last minute changes, see col. 1, lines 47-64; col. 2, lines 45-58; and col. 5 line 66 – col. 6 line 46.

Vogel (5,371,795) which also teaches controlling a VCR with messages sent from a content source to ensure a program is recorded properly in spite of last minute changes, see col. 8, lines 7-26.

Young (4,706,121) which teaches controlling a VCR for unattended recording and adjusting for schedule changes, see col. 5, lines 37-56.

8. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dominic D. Saltarelli whose telephone number is (571) 272-7302. The examiner can normally be reached on Monday - Friday 7:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DS



JOHN MILLER  
SUPERVISORY PATENT EXAMINER  
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